

REMARKS

The Office Action of June 16, 2008 was received and carefully reviewed. Reconsideration and withdrawal of the currently pending rejections are requested for the reasons advanced in detail below.

Claims 1, 77-84, 87-90, 93-103, 105, 106 and 108-153 were pending prior to the instant amendment. By this amendment, claims 1, 77-80 and 122-125 are amended. Consequently, claims 1, 77-84, 87-90, 93-103, 105, 106 and 108-153 are currently pending in the instant application with claims 1, 77-80 and 122-125 being independent.

In the Office Action, claims 1, 77, 79-81, 83, 84, 87, 89, 90, 93, 95-98, 100-103, 106, 108-111, 113-116 and 122-149 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 11-154714 and the Derwent Translation of this document to Yamazaki et al. (Yamazaki) and U.S. Patent No. 5,844,274 to Tsutsumi (Tsutsumi); claims 117, 118, 120, 121 and 150-153 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamazaki and Tsutsumi, as applied to claim 1 above, and further in view of U.S. Patent No. 5,656,845 to Akbar (Akbar); claims 78, 82, 88, 94, 99, 105 and 112 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamazaki and Tsutsumi, as applied to claim 1 above, and further in view of U.S. Patent no. 5,793,344 to Koyama (Koyama); and claim 119 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamazaki, Tsutsumi and Koyama, as applied to claim 78 above, and further in view of Akbar. These rejections are respectfully traversed for at least the reasons provided below.

Yamazaki, Tsutsumi, Koyama and/or Akbar, however, fail to render the claimed invention unpatentable. Each of the claims recite a specific combination of features that distinguishes the invention from the prior art in different ways. For example, independent

claims 1, 78, 79, 122 and 124 similarly recite a combination that includes, among other things:

... wherein a border of the channel forming region and the drain region is aligned with an edge of the layer.

Independent claims 77, 80, 123 and 125 similarly recite yet another combination that includes, *inter alia*,

... wherein a border of the channel forming region and the drain region is aligned with an edge of the floating gate.

(See, for example, Fig. 6D and page 26, lines 11-18 of specification). At the very least, the applied references, whether taken alone or in combination, fail to disclose or suggest any of these exemplary features recited in independent claims 1, 77-80 and 122-125.

The Examiner has failed to establish a *prima facie* case of obviousness for at least four reasons. First, the Examiner has not demonstrated how Yamazaki, Tsutsumi, Akbar and/or Koyama, whether taken alone or in combination, disclose or suggest each and every feature recited in the claims. *See* M.P.E.P. § 2143 (7th ed. 1998). Second, the Examiner has not shown the existence of any reasonable probability of success in modifying Yamazaki, the base reference, based on the teachings of Tsutsumi, Akbar and/or Koyama, the secondary references, in a manner that could somehow result in the claimed invention. *See id.* Third, the Examiner has not identified any suggestion or motivation, either in the teachings of the applied references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the apparatus of Yamazaki in a manner that could somehow result in the claimed invention. *See id.* Finally, the Examiner has not explained how his obviousness rationale could be found in the prior art — rather than being a hindsight reconstruction of Applicants' own disclosure. *See id.*

Each of the Examiner's factual conclusions must be supported by "substantial evidence" in the documentary record, as required by the Federal Circuit. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness "less the 'haze of so-called expertise' acquire insulation from accountability." *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b) and 103. In this case, however, the Examiner has failed to satisfy his burden of demonstrating how Yamazaki, taken alone or in combination with Tsutsumi, Akbar and/or Koyama, can either anticipate or render obvious each and every one of the limitations present in independent claims 1, 77-80 and 122-125, as required by the M.P.E.P. and Federal Circuit jurisprudence.

With respect to independent claims 1, 77-80 and 122-125, the Examiner asserts that Yamazaki, taken in combination with Tsutsumi and/or Koyama, makes obvious the present invention. However, Applicants have amended independent claims 1, 77-80 and 122-125 to recite the features of "wherein a border of the channel forming region and the drain region is aligned with an edge of the layer (the floating gate)." (See, for example, Fig. 6D and page 26, lines 11-18 of specification). Applicants contend that the features of wherein a border of the channel forming region and the drain region is aligned with an edge of the layer (the floating gate) are not taught or suggested by Yamazaki. Further, in Yamazaki, the border of the channel forming region 344 and the drain region 322 is **not** aligned with the edge of the floating gate as shown in Fig. 7B, for example. Applicants further contend that Tsutsumi also fails to overcome the deficiencies of Yamazaki by teaching or suggesting the features of wherein a border of the channel forming region and the drain region is aligned with an edge of the layer (the floating gate), as presently claimed.

In accordance with the M.P.E.P. § 2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 196 (CCPA 1970). Therefore, it is respectfully submitted that neither Yamazaki, Tsutsumi, Akbar nor Koyama, taken alone or in any proper combination, discloses or suggests the subject matter as recited in claims 1, 77-80 and 122-125. Hence, withdrawal of the rejection is respectfully requested.

Each of the dependent claims depend from one of independent claims 1, 77-80 or 122-125 and are patentable over the cited prior art for at least the same reasons as set forth above with respect to claims 1, 77-80 and 122-125.

In addition, each of the dependent claims also recite combinations that are separately patentable.

In view of the foregoing remarks, this claimed invention, as amended, is not rendered obvious in view of the prior art references cited against this application. Applicant therefore request the entry of this response, the Examiner’s reconsideration and reexamination of the application, and the timely allowance of the pending claims.

In discussing the specification, claims, and drawings in this response, it is to be understood that Applicant in no way intends to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned agent at (202) 585-8100.

Respectfully submitted,

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